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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,300	06/05/2001	Matthew A. Parker	1510.1001	5700
21171	7590	12/01/2006	EXAMINER GOTTSCHALK, MARTIN A	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			ART UNIT 3694	PAPER NUMBER

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/873,300

Applicant(s)

PARKER, MATTHEW A.

Examiner

Martin A. Gottschalk

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09/60/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Notice to Applicant***

1. Claims 1-23 are pending. Claims 1, 22, and 23 are amended; the remaining claims are original.

***Claim Rejections - 35 USC § 112***

2. The rejections under this section in the previous Office Action are hereby withdrawn.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1, 2, 8-14, and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonin (US PG Pub# 2002/0116233, hereinafter Bonin) in view of Thomas (US PG Pub# 2002/0138309, hereinafter Thomas).

A. As per claim 1, Bonin discloses a method of providing preferred patient services, comprising:

associating a plurality of doctors (Bonin: Fig. 1, item 10, reads on "Select Participating Physicians...") in various locations (Bonin: [0040], reads on "...a plurality of primary care physicians selected on the basis of geographic location.") with an organization (Bonin: Fig 1. The Examiner considers the execution of the various steps of Fig 1 to be a form of creating an organization to make and market the disclosed videotapes. The Examiner further considers the selected "participating physicians" to be associated with the organization."), the associated doctors being selected by the organization based on each doctor's respective credentials (Bonin: [0006].).

Bonin fails to explicitly disclose

charging a membership fee to allow a plurality of members to belong to the organization, the members being permitted to seek any number of visits with any of the associated doctors in any of the various locations

wherein the organization does not provide primary health insurance, but provides additional medical care regardless of any health insurance a member may already possess

However, these features are well known as evidenced by the teachings of Thomas. Thomas discloses

charging a membership fee to allow a plurality of members to belong to the organization, the members being permitted to seek any number of visits with any of the associated doctors in any of the various locations (Thomas: [0006]. The Examiner considers the "rebate" as described to be a form of payment of a membership fee in the sense that it is paying for membership to an organization that will provide or pay for health care services. Note the statement that the account can be used to pay for purchases of "different kinds" of insurance policy premiums or for "various services" associated with an insurance policy).

wherein the organization does not provide health insurance, but provides additional medical care regardless of any health insurance a member may already possess (Thomas: [0029]. The Examiner notes that "gap insurance" is not primary insurance, but provides additional medical care not covered by a primary policy. See section 112, paragraph 2 rejection above.).

It would have been obvious at the time of the invention to one of ordinary skill in the art to incorporate the teachings of Thomas within the method of Bonin. Bonin teaches a method for selecting a primary care physician (Bonin: [0005]), while Thomas teaches a method of paying for health care (Thomas: [0006]). The skilled artisan would have recognized the utility of combining the selection of a doctor with payment of the premium for the insurance that would subsequently reimburse the doctor for any service rendered, the motivation of the combination being to improve the capacity of the individual seeking medical care to pay for the medical care sought (Thomas: [0004] – [0005]).

Note: the same motivation to combine references applies to claims 2, 14, and 18-20 which follow in this section.

B. As per claim 2, Thomas discloses a method as recited in claim 1, wherein

the organization is promoted through a credit card company (Thomas: [0041]).

C. As per claims 8 and 9, Bonin discloses a method as recited in claim 1 wherein the various locations comprise various

Art Unit: 3694

(claim 8) cities;

and

(claim 9) countries (Bonin: [0040]. The Examiner considers the disclosed "...useful grouping of primary care physicians selected on the basis of geographic location...where the physicians provide their service..." to include groupings based on cities and countries).

D. As per claim 10, Bonin discloses a method as recited in claim 1, wherein the selected doctors comprises

a preexisting network of doctors (Bonin: [0040], reads on "...physicians provide their service in conjunction with several clinic facilities or hospitals.").

E. As per claims 11 and 12, Bonin discloses a method as recited in claim 1, wherein a member can access a list of the selected doctors

(claim 11) and identify a doctor in a particular location by using the Internet (Bonin: [0038], wherein "the medium" refers to video representations of physicians for the consumer to select from, delivered to the consumer "...by a stream of data over the internet...");

and

(claim 12) via a toll free telephone number (Bonin [0031], reads on “teleservices video bio-phone line”).

F. As per claim 13, Bonin discloses a method as recited in claim 1, wherein the selected doctors

possess excellent credentials, as judged by the organization (Bonin: [0016]-[0020]. Note that the disclosed method includes preparing physicians for “proper performance expectations” [0016] geared toward inducing a patient to select them to be that patient’s doctor. This includes the use of “predetermined guidelines and standards”... [for]...“Portrayal of the physician...to convey physician...credentials...” [0020]. The Examiner considers that average or mediocre credentials would not be considered helpful in such a portrayal, and that only high quality - i.e. “excellent” - credentials would be judged by the organization to be worthy of portrayal, and that this would be included in the guidelines and standards of the organization.).

G. As per claim 14, Thomas discloses a method as recited in claim 1, wherein



the associated doctors pay a fee to be associated with the organization (Bonin: [0029], note the disclosed determination of a "...return on investment based on at least a cost to produce the video visit videotape..." The Examiner considers this "investment" to be read on by fee.).

H. As per claim 18, Thomas discloses a method as recited in claim 1, wherein

the members pay the membership fee to a credit card company (Thomas: [0019], fee reads on "rebates").

I. As per claim 19, Thomas discloses a method as recited in claim 18, wherein

the credit card company pays an associated doctor for conducting a visit with a member of the organization (Thomas: [0041], discloses "instantaneous transfer of funds" by use of a card to health care "...providers who provide a discount of their services to the clients.").

J. As per claim 20, Thomas discloses a method as recited in claim 1, wherein the membership fee is

non-subsidized (Thomas: [0036], note the disclosed payment of deductibles.

The Examiner notes that deductibles may vary between consumers having the

same insurance payer, for instance an older person who is more likely to be sick than a younger person might have to assume a higher deductible policy than the younger person. This contrasts to the description provided in Applicant's specification on page 5, where a "subsidized pricing structure is one where patients typically pay the same price regardless of their medical situation".)

K. As per claim 21, Bonin discloses a method as recited in claim 1, wherein

the associated plurality of doctors are private practitioners (Bonin: [0040], reads on "practice group").

6. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonin in view of Thomas as applied to claim 2 above, and further in view of Tuzhilin (US Pat# 6,236,978, hereinafter Tuzhilin).

A. As per claims 3-7, Bonin discloses a plurality of ways to conduct market research (Bonin: [0042]) and to promote the video visit system (Bonin: [0041]) which suggest the features recited in claims 3-7, though the combined teachings of Bonin and Thomas fail to explicitly teach the features of claims 3-7.

However, these features are well known in the art as evidenced by the teachings of Tuzhilin, who discloses a system for dynamically profiling the purchasing

Art Unit: 3694

characteristics of individual users, and aggregating these profiles into more generalized rules that characterize groups of users (Tuzhilin : col 2, lns 24-59; col 3, lns 30-35).

i. As per claim 3, Tuzhilin discloses a method as recited in claim 2, wherein

the credit card company offers membership to the organization to a potential member based on purchasing characteristics of the potential member (Tuzhilin: col 3, lns 30-33, reads on "user profiles").

ii. As per claim 4-7, Tuzhilin discloses a method as recited in claim 3, wherein the purchasing characteristics of the potential member comprises

(claim 4) frequent travel (Tuzhilin: col 3, lns 30-34, reads on business travel locations).

(claim 5) frequent international travel (Tuzhilin: col 11, lns 25-29).

(claim 6) high spending (Tuzhilin: col 3, lns 63-64, reads on " '...prefers to have lunches at expensive seafood restaurants...' ").

(claim 7) a high income (Tuzhilin: col 6, lns 17-29).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the disclosures of Tuzhilin with the collective teachings of Bonin and Thomas with the motivation of generating more reliable dynamic profiles by analyzing a large number of rules (Tuzhilin: col 3, lns 11-21), thus providing improved purchasing recommendations to users (Tuzhilin: col 10, lns 50-55), for the purchase of health insurance for instance.

7. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonin in view of Thomas as applied to claim 1 above, and further in view of Sato (US Pat# 5,911,687, hereinafter Sato).

A. As per claims 15-17, the features of these claims are not explicitly disclosed by the combined teachings of Bonin and Thomas. However, these features are well known in the art as evidenced by the teachings of Sato

i. As per claim 15, Sato teaches a method as recited in claim 1, wherein

the visit a member seeks with an associated doctor is provided immediately (Sato: Fig. 9; col 9, lns 55-61).

ii. As per claim 16, Sato discloses a method as recited in claim 1, wherein

an associated doctor shares medical information regarding a member of the organization with other associated doctors using the Internet (Sato: Fig 1, item 100, Internet reads on "wide area network"; col 5, lns 44-58. Note that the plurality of doctors in the patients clinic – Fig 1, item 102 - share the same patient history information through the management center, see Fig 1, item 104).

- iii. As per claim 17, Sato discloses a method as recited in claim 1, wherein the organization can import and store a member's medical records from the member's regular doctor or primary health care provider (Sato: col 6, ln 65 to col 7, ln 10).

For claims 15-17, it would have obvious to one of ordinary skill in the art at the time of the invention to incorporate the disclosure of Sato with the combined teachings of Bonin and Thomas with the motivation of extending the geographic reach of a patient with respect to the patient's ability to receive convenient medical treatment from physicians selected by the patient (Sato: col 1, ln 65 to col 2, ln 5).

8. As per claim 22, all the limitations recited in claims 1-21 are combined into this single claim, thus the limitations in claim 22 are rejected for the same reasons and motivations as provided for the corresponding limitations in claims 1-22.

Claim 22 reads as follows:

A method of providing preferred patient services, comprising:

a. associating a plurality of doctors in various locations with an organization, the associated doctors being selected by the organization based on each doctor's respective credentials;

and

b. charging a membership fee to allow a plurality of members to belong to the organization, the members being permitted to seek any number of visits with any of the associated doctors in any of the various locations,

c. wherein the organization does not provide primary health insurance, but provides additional medical care regardless of any health insurance a member may already possess,

d. wherein the organization is promoted through a credit card company,

e. wherein the credit card company offers membership to the organization to a potential member based on purchasing characteristics of the potential member,

- f. wherein the purchasing characteristics of the potential member comprises frequent travel,
- g. wherein the purchasing characteristics of the potential member comprises frequent international travel,
- h. wherein the purchasing characteristics of the potential member comprises high spending,
- i. wherein the purchasing characteristics of the potential member comprises a high income,
- j. wherein the various locations comprise various cities,
- k. wherein the various locations comprise various countries,
- l. wherein the selected doctors comprises a preexisting network of doctors,
- m. wherein a member can access a list of the selected doctors and identify a doctor in a particular location by using the Internet,

- n. wherein a member can access a list of the selected doctors via a toll free telephone number,
- o. wherein the selected doctors possess excellent credentials, as judged by the organization,
- p. wherein the associated doctors pay a fee to be associated with the organization,
- q. wherein the visit a member seeks with an associated doctor is provided immediately,
- r. wherein an associated doctor shares medical information regarding a member of the organization with other associated doctors using the Internet,
- s. wherein the organization can import and store a member's medical records from the member's regular doctor or primary health care provider,
- t. wherein the members pay the membership fee to a credit card company,
- u. wherein the credit card company pays an associated doctor for conducting a visit with a member of the organization,



- v. wherein the membership fee is non-subsidized,
- w. wherein the associated plurality of doctors are private practitioners.

9. As per claim 23, it combines into this single claim the limitations of claims 1, 11, 18, and 19, thus the limitations in claim 23 are rejected for the same reasons and motivations as provided for the corresponding limitations in claims 1, 11, 18, and 19.

Claim 23 reads as follows:

A method of providing preferred patient services, comprising:

- a. associating a plurality of doctors in various locations with an organization, the associated doctors being selected by the organization based on each doctor's respective credentials; and
- b. charging a membership fee to allow a plurality of members to belong to the organization, the members being permitted to seek any number of visits with any of the associated doctors in any of the various locations,

- c. wherein the organization does not provide primary health insurance, but provides additional medical care regardless of any health insurance a member may already possess,
- d. wherein the member pay the membership fee to a credit card company,
- e. wherein the credit card company pays an associated doctor for conducting a visit with a member of the organization,
- f. wherein an associated doctor shares medical information regarding a member of the organization with other associated doctors using the Internet.

### ***Response to Arguments***

10. Applicant's arguments in the response filed 09/06/2006 have been fully considered but they are not persuasive. In essence, Applicant argues that the applied references of Bonin and Thomas can be removed by the Rule 131 affidavit provided. The Examiner respectfully disagrees and makes the following observations:

A. Evidence of conception is based on Applicant's Exhibit B. This exhibit fails to establish conception and possession of the invention of the features of the invention. The features of claim 22 serve as an example (see this claim's presentation above and

Art Unit: 3694

note the alphabetical lettering provided by the Examiner). Features of claim 22 not taught by Exhibit B include at least the following:

22b. Any number of visits with any doctor in any location;

22c. No mention is made of the provision of care “regardless” of other insurance (though the necessity of having other health care insurance is taught);

22e-i. the “purchasing characteristics” limitations;

22k. the “various locations” feature comprising “countries”;

22l. the “network of doctors” is “preexisting”;

22n. use of a “toll free telephone number”;

22p. doctor's pay a fee (though it is taught that they are paid a fee);

22q. a doctor's visit is provided “immediately” (though “rapid access” is taught);

22t. members pay a credit card company (though it is taught that the service can be “marketed” by a credit card company);

22u. credit card company pays doctor;

22v. fee is "non-subsidized";

22w. associated doctors are "private practitioners" (though institutions "like the Mayo Clinic and Johns Hopkins" are taught).

B. For argument's sake, though it is not at all conceded, given that conception is established, proof of diligence remains lacking for at least the following reasons:

i. Between May 2000 and October 2000 (the declaration recites 2005 as the year, though from context it will be presumed that the correct year is intended to be 2000), there is no apparent diligence.

ii. From October 2000 to April 29, 2001, there is no apparent diligence.

iii. For the month of May 2001, there is no apparent diligence.

C. More generally, no documentation of Applicant's statements concerning diligence are provided, for example:

- i. meeting with patent attorneys on April 15, 2000;
- ii. the patent search performed in May of 2000;
- iii. phone discussions in October of 2000;
- iv. receipt of a draft application on April 29, 2001.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is (571) 272-7030. The examiner can normally be reached on Mon - Fri 8:30 - 5:00.

Art Unit: 3694

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MG  
11/22/2006



ELLA COLBERT  
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